

REMARKS / ARGUMENTS

Reconsideration of the application as amended is respectfully requested.

Before entry of the present amendment, Claims 1-4 and 8-14 were pending, and presently, Claims 1-4 and 8-14 stand rejected. Claim 8 have been amended as indicated, and all Claims 1-4 and 8-14 are presently considered in a condition for allowance.

The examiner object to spelling errors and the indefinite phrase “linear carousel” as informalities that required correction. The applicant has amended the specification to eliminate spelling errors and the improper references.

The examiner respectfully rejected Claims 1-4 and 8-14 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification to reasonably convey possession of the claimed invention at the time the application was filed.

The spring (20) urges each individual slide (14) forward after the displayed slide has been displaced. The gripping brackets (18) are guided by the track (16) in either the forward or return directions. Upon actuation of the switch (38) to displace the previously displayed slide and to advance to the subsequent slide, the switch (38) communicates with the spring (20) to cause the forward urging along the linear slide advancement mechanism.

The examiner respectfully rejected Claims 1-4 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Besancenot in view of Laizans, et al.

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP §

706.02(j).

Several differences exist between Besancenot, Laizans et al. and the present invention. Besancenot fails to disclose the combination of a portable slide projector having a linear slide advancement mechanism wherein individual brackets and springs urge each subsequent slide forward toward a projection means and then return the previously displayed slide to the rear of the plurality of slides. Besancenot also fails to disclose a lamp which pivots from behind a slide to the side so that the slide advancement mechanism may urge the next slide forward. Laizans et al. discloses a tapered projector, having a wide rear portion and a more narrow front portion. Thus, the examiner's rejection of Claims 1-4 and 8 is inappropriate, and as such, Claims 1-4 and Claim 8 are presently considered allowable in light of the arguments provided.

The examiner respectfully rejected Claims 9-11 under 35 U.S.C. § 103(a) as being unpatentable over Besancenot in view of Laizans, et al. and in further view of LiDonnici et al.

The examiner cites LiDinnici et al. for rejecting Claim 9 based on the disclosure of a door (20). However, LiDinnici et al. fails to disclose an access door which opens in a clam-shell fashion and provides access to entire interior cavity of the housing. The door (20) cited by the examiner gives no indication that the door is of the type disclosed by the present application. Thus, the combination of Besancenot, Laizans, et al. and LiDinnici et al. does not disclose nor suggest every element of Claim 9 as required, therefore Claims 9 should be in a condition for allowance.

As to Claim 10, the combination of references does not disclose nor suggest every element of Claim 10, in particular, failing to disclose a housing access door pivotally affixed for

providing access to the internal cavity of the housing.

As to Claim 11, the combination of references does not disclose nor suggest every element including the pivotal projector lamp that is resiliently deformed and the rechargeable batter pack provided at the rear of the housing.

Thus, the combination of Besancenot, Laizans, et al. and LiDinnici et al. does not disclose nor suggest every element of Claims 9-11 as required, therefore Claims 9-11 should be in a condition for allowance.

The examiner respectfully rejected Claims 12-14 under 35 U.S.C. § 103(a) as being unpatentable over Besancenot in view of Laizans, et al. and in further view of LiDonnici et al. and in further view of Johannsen, et al.

The differences previously noted between the present invention and cited references Besancenot, Laizans, et al. and LiDonnici et al. are hereby incorporated by reference to avoid repetitive arguments. Johannsen et al. is cited by the examiner for disclosing a pair of legs for supporting and providing pitched inclination to the apparatus. However, Johannsen et al. discloses a single front leg and a dual rear leg, each of which are adjustable. The present invention includes only a front leg that is vertically adjustable. The rear leg is a fixed height, thereby reducing the moving parts, the possibility for the future need to replace said part, and reducing the cost of manufacturing the invention. As such, the combination of Besancenot, Laizans, et al., LiDonnici et al. and Johannsen et al. do not disclose nor suggest every element of the Claims 12-14 as required, and as such, Claims 12-14 are presently considered allowable.

Based upon the above arguments, it is felt that the differences between the present

invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a portable slide projector having a tubular housing, a linear slide

advancement mechanism with a plurality of brackets and springs for advancing single slides.

Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ 2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and a formal Notice of Allowance is respectfully requested at the earliest possible date.

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